

## REMARKS

Upon entry of the amendments, claims 1-6, 12, 13, 18-20, 24, 27, and 29 will be pending in the application. Applicants provide the following comments in regards of the Office Action.

### ***Claim Rejections – 35 U.S.C. § 112***

Claim 27 is rejected for failing to comply with the enablement requirement.

Applicants assert that claim 27 identifies a particular group of diseases or conditions (i.e. obesity, diabetes, depression, anxiety and neurodegeneration in a mammal). These diseases are known by one skilled in the art to be impacted by glucocorticoid modulation. Hence, the claim and the supporting disclosure enables a person skilled in the art to make and use the claimed invention. Reference is made to the specification (for example, pages 29 and 30).

Claims 1-6, 12, 13, 18-20, 24, 27, and 29 are rejected as indefinite. Applicants have amended the claim set to obviate this rejection.

### ***Claim Rejections – 35 U.S.C. § 102***

The Office Action maintains/issues the following rejections:

- 1) claims 1-4, 12, 13, 24, 27, and 29 based upon Dow (U.S. Patent 6,380,233), and
- 2) claims 1 and 3-6 based upon Murry (U.S. 2002/0087005).

Regarding the first rejection, the Office Action asserts that Dow is 102(b) prior art that discloses R<sub>4</sub> as being –O-C(O)-NH-(CH<sub>2</sub>)<sub>2</sub>-N(CH<sub>3</sub>)<sub>2</sub> in the following compound: carbamic acid, [2-(dimethylamino)ethyl]-, (4b, 5,6,7,8,8a,9,10-octahydro-7-hydroxy-4b-(phenylmethyl)-7-(1-propynyl)-2-phenanthrenyl ester[4bS-(4b $\alpha$ ,7 $\alpha$ ,8 $\alpha\beta$ )-.

Dow fails to qualify as 102(b) prior art. Dow issued on 4/30/2002 and the present application was filed on 10/26/2001. Most likely the present Office Action contains a typographical error because the prior Office Action utilized Dow as 102(e) prior art. Applicants will proceed under the assumption that Dow is being relied upon as 102(e) prior art.

Applicants attest that Dow fails to inherently or explicitly disclose all the features of independent claim 1 because of the following proviso:

“when R<sub>1</sub> is –C $\equiv$ C-CH<sub>3</sub>, R<sub>2</sub> is phenyl and R<sub>3</sub> is hydrogen, then R<sub>4</sub> is other than –(CH<sub>2</sub>)<sub>2</sub>-N(CH<sub>3</sub>)<sub>2</sub>, or –(CH<sub>2</sub>)<sub>3</sub>-N(CH<sub>3</sub>)<sub>2</sub>”.

Hence, independent claim 1 does not encompass the compound (having 2-(dimethylamino)ethyl with the other specified conditions) referenced in the Office Action.

Applicants likewise assert that the dependent claims (2-4, 12, 13, 24, 27, and 29) are not anticipated by Dow.

Regarding the second rejection, Applicants respectfully assert that Murry fails to anticipate the subject matter of independent claim 1 and dependant claims 3-6 because of the aforementioned provisio.

### ***Claim Rejections – 35 U.S.C. § 103***

Claims 1-6, 12, 13, 18-20, 24, 27, and 29 are rejected as obvious in view of Dow. As previously discussed, Dow does not qualify as 102(b) prior art. As such, the undersigned assumes that the cited patent is being relied upon as 102(e) prior art.

Applicants respectfully assert that this rejection should be withdrawn because of 35 U.S.C. § 103(c). The following statement is being presented so that the rejection can be withdrawn.

### **Statement of Common Ownership**

The subject matter of the present application and the cited patent (Dow), at the time the invention of the present application was made, were commonly owned (by the assignee Pfizer, Inc.) or subject to an obligation of assignment that would establish common ownership.

### ***Double Patenting***

Claims 1-6, 12, 13, 18-20, 24, 27, and 29 are rejected under the judicially created doctrine of obvious-type double patenting in view of US 6,699,893 filed on February 19, 2002.

Applicants dispute that the rejected claims are obvious variants of claims 1-4, 27-30, 32, 41, 42, 47, 48, 50, 52, 56, 67, 69, 71, and 73-75 of US 6,699,893. The Office Action relies upon the formula  $Z-(CO)-NR_{12}-Z-NR_{12}R_{13}$ , however, the cited patent claims that Z is a  $C_1-C_6$  alkyl,  $C_2-C_6$  alkenyl, or  $C_2-C_6$  alkynyl. Therefore, the present claims would not be considered obvious.

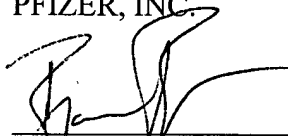
Applicants note the provisional double patenting rejection based upon copending Application No. 10/721,318.

***Conclusion***

In light of the foregoing, Applicants request withdrawal of the claim rejections, and solicit an allowance of the claims. The examiner is invited to contact the undersigned attorney should any issues remain unresolved. If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 19-1025. Any overpayment can be credited to Deposit Account No. 19-1025.

Respectfully submitted,

PFIZER, INC.



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